



Attorney Docket No. 017309/0173

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Josef Otto RETTENMAIER

Title: ANCILLARY FILTERING
AGENT

Appl. No.: 09/380,731

Filing Date: 09/13/1999

Examiner: S. Kim

Art Unit: 1723

DECLARATION OF DR. PETER PALGEN

I, Dr. Peter Palgen, a citizen of the Federal Republic of Germany, residing at Karl-Müller-Straße 19, D-40237 Düsseldorf, Germany, declare and state that:

1. I am a German Patent Attorney and have been retained by Mr. Josef Otto Rettenmaier to assist him with preparation and prosecution of above-captioned patent application SN 09/380,731.

2. I learned of the present invention for the first time by letter from the German company J. Rettenmaier + Söhne GmbH & Co, which is owned by Mr. Rettenmaier. The letter is attached as Exhibit A and dated December 27, 1995. The German company J. Rettenmaier + Söhne GmbH & Co. has an exclusive license in the invention of SN 09/380,731. This company changed its name to J. Rettenmaier + Söhne GmbH & Co. KG in the year 2000. Please refer to the enclosed copy of an extract from the commercial register attached as Exhibit B.

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3. The attachments to the December 27, 1995 letter were two statements used to describe the invention. In Germany, under certain circumstances, the government will partly finance research and development to support innovation. An applicant for such money has to file such statements concerning his development work so that the governmental authority is able to judge whether the investments are sensible and justified. The first statement is a status report attached as Exhibit C and titled "Schlußbericht zum 30. November 1995, Teil I "Laborphase"" (= Final report for November 30, 1995, Part I "Lab stage"), reporting the development results obtained up to November 30, 1995. The second statement is attached as Exhibit D and titled "Neubeantragung zum 1. Januar 1996, Part II "Weitere Entwicklung und Technikumsphase"" (= New Application for January 1, 1996, Part II "Further development and pre-production stage") reporting the intended activities for the time after January 1, 1996 as a basis for an application for further support money.

4. Exhibits C and D illustrate the state of development of the invention at the end of 1995.

5. Exhibits C and D disclose each feature of claim 1 of SN 09/380,731. That is, Exhibits C and D disclose a filter aid which comprises finely divided wood particles. See Exhibit C page 1 under "1 Zusammenfassung der Ergebnisse" subtitle "Laugenbehandelter Holzfaserstoff", which means "wood fibre stock treated with alkali". Wood fibre stock is a kind of finely divided wood particles. The expression "Laugenbehandelter Holzfaserstoff" is also used in section 2.1.5 and 2.3 of Exhibit C. Exhibit D mentions "Laugenbehandelter Holzfaserstoff" in section "3.2 Technikumsanlage" paragraph 2. The passages mentioned before also disclose that the filter aid comprises finely divided wood particles that have been subjected to treatment with an alkali solution (laugenbehandelt = treated with alkali) at a

temperature below 100°C and at atmospheric pressure. Exhibit C in the table in section "2.5 Technikumsanlage" discloses that the alkali treatment has taken place with a dilute alkali solution at a temperature below 100°C (0,1 - 0,4 %ige, heiße Natronlauge, Erhitzen der Natronlauge auf 90°C). Although atmospheric pressure is not expressly mentioned in Exhibits C and D, it is mentioned in claim 5 of Exhibit F which is dated February 29, 1996. Exhibit F is an initial draft of the German patent application to which SN 09/380,731 claims priority. The particles are subjected to the treatment to a degree sufficient to remove sensorially active substances from the wood particles and leave the wood particles as wood particles. This can be taken from Exhibit C, page 1, subtitle "Laugenbehandelter Holzfaserstoff", which reads "... ein chemischer Reaktionsschritt entwickelt, durch den sich der Anteil an extrahierbaren Bestandteilen in Holzfaserstoffen deutlich reduzieren läßt" (=developed a chemical reaction step, by which the part of extractable components in wood fibre stocks can be considerably reduced). The extractable components are equivalent to the "sensorially active substances" in claim 1.

That the particles are left as wood particles (and are not on their way to becoming real cellulose) is not expressly mentioned in Exhibits C and D, but is clearly described in Exhibit F, page 3, last paragraph to page 4, paragraph 4.

6. Exhibits C and D and further oral explanations served as the source of information for me to prepare the initial draft of the German patent application to which SN 09/380,731 claims priority. This initial draft application was sent to Mr. Rettenmaier by letter dated February 29, 1996. The letter is attached as Exhibit E, and, as mentioned above, the initial draft application is attached as Exhibit F. The draft application has been revised and improved several times. One of these improved versions is attached as Exhibit H, which

was sent to the company by letter dated September 10, 1996, attached as Exhibit G.

7. New claim 36 differs from claim 1 in that claim 36 additionally requires that the filter aid be "for use in forming prefloat filter layers for the filtration of liquids." This limitation would be understood by a person of ordinary skill in the art when reading through Exhibit C. The person would know that filtrations of the kind discussed are usually effected by prefloat filter layers. The words "Anschwemmbarkeit" (= floatability) in the paragraph bridging pages 1 and 2 of Exhibit C, "Filterkuchenhöhe" (= filter cake height) in the section "Spezielle Anforderungen der Filtration" on page 2 of Exhibit C, and "Filterkuchen" in the section "Wirtschaftlichkeit" on page 2 of Exhibit C confirm this understanding.

In Exhibit H of the draft application dated September 10, 1996, the prefloat filter layers are expressly mentioned on page 7 in paragraph 6.

8. As can be seen from Exhibits C and D, a functioning product existed long before January 1997. The experiments described in Exhibits C and D have been carried out with a product having the features of claim 1 and 36, respectively.

I declare under penalty of perjury under the laws of the United States of America that all statements made herein of my own knowledge are true and correct, and that all statements made on information and belief are believed to be true and correct.

Date:

October 4, 2002



Dr. Peter Palgen